

II. REMARKS

Formal Matters

Claims 1-20 and 22-61 are pending after entry of the amendments set forth herein.

Claims 1-40, 62, and 63 were examined. Claims 1-29, 39, 40, 62, and 63 were rejected. Claims 41-61 were withdrawn from consideration. Claims 30-38 were objected to.

Claims 1, 13, 22, 26, 30, 31, 33, and 40 are amended. The amendments to the claims were made solely in the interest of expediting prosecution, and are not to be construed as acquiescence to any objection or rejection of any claim. No new matter is added by the amendments to claims 1, 13, 22, 26, 30, 31, 33, and 40.

Claims 21, 62, and 63 are canceled without prejudice to renewal, without intent to acquiesce to any rejection, and without intent to surrender any subject matter encompassed by the canceled claims. Applicants expressly reserve the right to pursue any canceled subject matter in one or more continuation and/or divisional applications.

Applicants respectfully request reconsideration of the application in view of the remarks made herein.

PTO SB-08A form

Applicants note that the following reference, cited in the PTO SB-08A form submitted with the Information Disclosure Statement filed (IDS) on March 8, 2007 in this application, was lined through, indicating that this reference was not considered:

Wang and Ohnuma (2000) *Biochim. Biophys. Acta* 1529:33 ("Wang").

Applicants note that a copy of Wang was provided along with the March 8, 2007 IDS, and was uploaded on PAIR. Applicants provide herewith a further copy of Wang. Applicants respectfully request that the SB-08A form submitted with the March 8, 2007 IDS be initialed, thereby indicating that Wang was considered, and that the initialed SB-08A form be returned to Applicants.

Sequence compliance

The Office Action stated that the application fails to comply with the requirements of 37 C.F.R. §§1.821 – 1.825. The Office Action stated that sequences are set forth in Figure 12 that lack sequence identifiers.

Applicants note that Figures 12A-C indicate that the sequences depicted therein are SEQ ID NO:23 and 24. As such, Figures 12A-C are in compliance with 37 C.F.R. §§1.821 – 1.825.

Allowable subject matter

Applicants note with gratitude that claims 30-38 would be allowable if re-written in independent form.

Rejection under 35 U.S.C. §112, first paragraph

Claims 1-20, 39, 40, 62, and 63 were rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement.

Claim 1 is amended to include the language of claim 21. Claim 21 was not included in this rejection. As such, the rejection under 35 U.S.C. §112, first paragraph, of claim 1, and claims depending directly or indirectly from claim 1, may be withdrawn.

Rejection under 35 U.S.C. §102(a)

Claims 1-5, 11-15, and 21-29 were rejected under 35 U.S.C. §102(a) as allegedly anticipated by Martin et al. ((2003) *Nature Biotechnol.* 21:796; “Martin”).

Claim 1 as amended recites a method of identifying a gene product in a terpene biosynthetic pathway, the method involving producing a test cell by introducing into a genetically modified host cell an exogenous nucleic acid comprising a nucleotide sequence encoding a candidate gene product, where the genetically modified host cell produces a terpene pathway intermediate in an amount effective to inhibit growth of the genetically modified host cell, wherein the intermediate is a prenyl diphosphate; and determining the effect, if any, of expression of the candidate gene product on growth of the test cell. Martin relates to engineering a mevalonate pathway in *E. coli*. Martin neither discloses nor suggests a method as recited in claim 1 as amended. As such, Martin cannot anticipate claim 1 or any claim depending, directly or indirectly, therefrom.

Applicants submit that the rejection of claims 1-5, 11-15, and 21-29 under 35 U.S.C. §102(b) has been adequately addressed in view of the remarks set forth above. The Examiner is thus respectfully requested to withdraw the rejection.

III. CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number BERK-032.

Respectfully submitted,
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Date: October 23, 2009

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